

**REMARKS**

Claims 1-29, 31-34, 36-40, 42-49, and 51-57 are pending in the present application. Claims 1, 15, 17, 18, 21, 28, 31, and 51-57 have been amended. Claims 1, 15, 17, 18, 21, 28, and 31 are independent claims. The Examiner is respectfully requested to reconsider the outstanding rejections in view of the above amendments and the following remarks.

***Rejection Under 35 U.S.C. § 112***

Claims 1, 15, 17, 21, 28, and 31 stand rejected under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, for allegedly failing to comply with both the enablement requirement and the written description requirement. This rejection is respectfully traversed.

**Enablement**

The legal standard for determining whether the enablement requirement is satisfied is whether one reasonably skilled in the art could make or use the information from the disclosure coupled with information known in the art without undue experimentation. *United States v. Telectronics, Inc.*, 9 USPQ2d 1217, 1223 (Fed. Cir. 1988).

The Examiner asserts that the following elements in claims 1, 15, 17, 21, 28, and 31 are not enabled:

*“...a receiving unit configured to receive the plurality of images via wireless communications with the one or more digital cameras”*

*“...a controller operable to control said capturing device and to control a communication device capable of being connected to said capturing device to wirelessly communicate with an external apparatus, wherein...”*

*“wherein the external apparatus is adapted to automatically store said plurality of images captured and transmitted by a plurality of capturing devices and to create image IDs respectively assigned to said plurality of images, each of said image IDs being linked to a predetermined web page on the internet.”*

Presumably, the Examiner takes the position that the present specification only enables the combination of a digital camera and mobile phone to communicate with the delivery-medium producing apparatus.

Applicants respectfully disagree with the Examiner's position. In describing the use of a mobile phone (page 9, lines 20-26), the present specification enables the broader concept of conducting wireless communications between the digital camera and delivery-medium producing apparatus. The present claims are not limited to **direct** wireless communications between a digital camera and a delivery-medium producing apparatus. Instead, the claim language also covers embodiments where the camera **indirectly** communicates with the delivery-medium producing apparatus, e.g., via a mobile phone.

Furthermore, persons of ordinary skill in the technical field would know how to implement a mechanism other than a mobile phone to perform wireless communications between the digital camera and delivery-medium producing apparatus, without undue experimentation.

Accordingly, Applicants respectfully submit that claims 1, 15, 17, 21, 28, and 31 satisfy the enablement requirement of § 112, 1<sup>st</sup> paragraph. Therefore, the Examiner is requested to withdraw this rejection.

### **Written Description**

The legal standard for determining whether the written description requirement is satisfied is whether the subject matter in the claims is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention at the time the application was filed. See *Vas-Cath, Inc. v. Mahurkar*, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991).

The Examiner asserts that the following claim element does not comply with the written description requirement: “*...a receiving unit configured to receive the plurality of images via wireless communications with the one or more digital cameras...*” The Examiner is presumably

taking the position that claims must recite that the camera wirelessly communicates with the delivery-medium producing apparatus via a mobile phone, since this is the embodiment disclosed in the specification. Applicants respectfully disagree.

There is no per se requirement under § 112, 1<sup>st</sup> paragraph for the claims to recite the subject matter as narrowly as described in the specification. In general, the only time where the omission of an element raises an issue regarding the written description requirement is when such element is described by an applicant as being essential or critical to the invention. See MPEP § 2163.I.B, 3<sup>rd</sup> paragraph.

Furthermore, there is a strong presumption that there is an adequate written description of the originally filed claims (see MPEP § 2163.I.A, 1<sup>st</sup> paragraph). In this case, the original claims recited “*a receiving unit operable to receive a plurality of images from a plurality of users*,” without requiring a mobile phone (see original claim 1).

It is respectfully submitted that persons of ordinary skill in the art would understand from the specification that wireless communications between the camera and delivery-medium producing apparatus, with or without a mobile phone, were within the Applicants’ possession as of the effective filing date of the present application. Accordingly, Applicants submit that the claims satisfy the written description requirement of § 112, 1<sup>st</sup> paragraph. Therefore, this rejection should be withdrawn.

#### ***Rejection Under 35 U.S.C. § 103***

##### **Rejections based on Fredlund/Steinberg**

Claims 1-14, 28, 36, 42, 43, 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,666,215 to Fredlund et al. (hereafter “Fredlund”) in view of U.S. Patent No. 6,750,902 to Steinberg et al. (hereafter “Steinberg”).

Further, dependent claim 29 stands rejected under § 103(a) as being unpatentable over Fredlund and Steinberg in view of U.S. Patent No. 5,737,491 to Allen et al (hereafter “Allen”).

In addition, claims 31-34, 49, and 57 stand rejected under § 103(a) as being unpatentable over Fredlund and Steinberg in view of Japanese Patent Publication 10078918 to Enomoto et al (hereafter “Enomoto”).

The abovementioned rejections, insofar as they pertain to the presently pending claims, are respectfully traversed.

Without admitting the appropriateness of this rejection, Applicants have amended claims 1, 28, and 31 to further distinguish over the above-identified references, in an effort to expedite prosecution. As amended, these independent claims now recite, *inter alia*, a digital camera which is programmed to automatically determine when the image transmitting condition is met without the user inputting a transmission command and **without receiving an external instruction that the condition is met**. None of the cited references, taken separately or in combination, teaches or suggests the aforementioned claim feature.

In the rejection, the Examiner acknowledges that Fredlund fails to teach a digital camera which is configured to automatically determine when an image transmitting condition is met without the user inputting a transmission command (see Off. Act. at pg. 4). The Examiner relies on Steinberg for this feature. However, according to Steinberg, a **communication device 10 is required to instruct the digital camera 12** when to upload captured images to the communication device 10 so that the images can be relayed to the destination 18 (see col. 5, lines 18-29). As such, both Steinberg and Fredlund fail to teach or suggest a digital camera programmed to automatically determine when an image transmitting condition is met **without receiving an external instruction**, as claimed.

Furthermore, Applicants submit that neither Allen nor Enomoto remedies the deficiencies of Fredlund and Allen mentioned above. In particular, the Examiner admits that Allen fails to disclose either a transmitting module or a controller in a digital camera which is configured to automatically determine when an image transmitting condition is met without the user inputting a transmission command (see Off. Act. at pgs. 26 and 30). As to Enomoto, the Examiner also

admits that this reference fails to disclose a digital camera configured to automatically determine when an image transmitting condition is met without the user inputting a transmission command (see Off. Act. at pg. 18). As such, Allen and Enomoto fail to remedy the deficiencies in Fredlund/Steinberg.

At least for the reasons set forth above, Applicants submit that independent claims 1, 28, and 31 are allowable. Accordingly, claims 2-14, 29, 32-34, 36, 42, 43, 48, 49, and 57 are allowable at least by virtue of their dependency on an allowable independent claim. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

**Rejection based on Enomoto/Steinberg**

Claims 15-17, 44, 45, 52, 53 stand rejected under § 103(a) as being unpatentable over Enomoto in view of Steinberg. This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Without conceding the appropriateness of this rejection, independent claims 15 and 17 have been amended to further distinguish over Enomoto and Steinberg. In particular, these claims have also been amended to recite, *inter alia*, a digital camera programmed to automatically determine when the image transmitting condition is met without the user inputting a transmission command and **without receiving an external instruction that the condition is met**. Enomoto Steinberg, taken separately or in combination, fails to teach or suggest this feature.

The Examiner admits that Enomoto fails to teach a digital camera which automatically determines when an image transmitting condition is met without the user inputting a transmission command (see Off. Act. at pg. 18). Further, as mentioned above, Steinberg teaches that an external communication device is required to instruct the digital camera when to transmit the digital image to the destination (see col. 5, lines 18-29). As such, neither references teaches or suggest a digital camera which automatically determines when an image transmitting condition is met without receiving an external instruction as claimed.

At least for the reasons set forth above, Applicants respectfully submit that independent claims 15 and 17 are in condition for allowance. Accordingly, claims 16, 44, 45, 52, 53 are allowable at least by virtue of their dependency on an allowable independent claim. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

**Rejection based on Allen/Steinberg**

Claims 18-27, 37-40, 46, 47, 54, and 55 stand rejected under § 103(a) as being unpatentable over Allen in view of Steinberg. This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Without conceding the appropriateness of this rejection, Applicants have also amended independent claims 18 and 21 to further distinguish over the applied references. Specifically, amended claim 18 recites, *inter alia*, a digital camera with a module programmed to automatically determine when the image transmitting condition is met without the user inputting a transmission command and **without receiving an external instruction that the condition is met**. Similarly, amended claim 21 recites, *inter alia*, a capturing device with a controller programmed to automatically determine when the image transmitting condition is met without the user inputting a transmission command and **without receiving an external instruction that the condition is met**. Applicants submit that Allen and Steinberg, taken alone or separately, fail to teach or suggest these features.

The Examiner admits that Allen fails to disclose a transmitting module or controller which is programmed to automatically determine when the image transmitting condition is met without the user inputting a transmission command (see Off. Act. at pgs. 26 and 30). Steinberg requires an external communication device to instruct the digital camera when to transmit the digital image to the destination (see col. 5, lines 18-29). Therefore, Allen and Steinberg fail to provide a teaching or suggestion of every claimed feature.

At least for the reasons set forth above, Applicants submit that independent claims 18 and 21 are in condition for allowance. Accordingly, claims 19, 20, 22-27, 37-40, 46, 47, 54, and 55

are allowable at least by virtue of their dependency on an allowable independent claim. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

*Conclusion*

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider the outstanding rejections and issue a Notice of Allowance in the present application.

Should the Examiner believe that any outstanding matters remain in the present application, the Examiner is respectfully requested to contact Jason W. Rhodes (Reg. No. 47,305) at the telephone number of the undersigned to discuss the present application in an effort to expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: January 30, 2009

Respectfully submitted,

for   
By Michael R. Cammarata #47,305  
Michael R. Cammarata  
Registration No.: 39,491  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant